

REMARKS

In the Office Action, claims 15-21 and 36-34 were indicated as allowed, and claims 22-35 were rejected. All the claims pending in the application are believed to be in condition for allowance, and their reconsideration is requested.

The rejected claims include two independent claims, namely claims 22 and 29. The Examiner formulated the rejection on the basis of 35 U.S.C. §103(a), indicating that the subject matter of these claims is unpatentable over Jago et al. (U.S. Patent No. 5,938,607; hereinafter "Jago") in view of an excerpt from a Microsoft manual entitled "Microsoft Exchange STEP BY STEP" (hereinafter "the Microsoft document").

The Examiner characterized the discussion of the Board of Patent Appeals and Interferences, in their decision of January 18, 2005, as concluding that Jago taught all elements of claims 22 and 29 except the automatic acknowledgment of a submitted service request. It is Applicants' understanding that, in fact, the Board concluded that the combination of Jago and a secondary reference did not teach automatic acknowledgment or reply to such a service request. Overlooking the fact that the Examiner no longer relied upon the secondary reference, and now relies upon Jago in combination with the Microsoft document, Applicants still submit that: (1) the Microsoft document does not provide for automatic acknowledgement of service requests as claimed; and (2) the Examiner has advanced no reasonable basis for combination of these references.

First, the Microsoft document does set forth a well understood mechanism for informing users that an e-mail recipient is absent. The very page relied upon by the Examiner, however, clearly indicates that all e-mails to the out-of-office recipient *will not be answered*. Indeed, many such messages could clearly go unanswered. The document states:

[b]efore you leave your office upon extended period of time, the first thing you'll probably want to do is create an AutoReply, which is a feature of the Out-Of-Office Assistant. An AutoReply is a text message that is sent to each person who sends you mail. The Out-Of-Office Assistant sends *only one response to each person that has sent you mail -- regardless of the number of times the person sends you messages. This avoids sending each person duplicate AutoReply messages.* When you return to the office and log on to Microsoft Exchange to resume replying to your own messages, you are reminded that the Out-of-Office Assistant is activated so that you don't forget to turn it off.

The Microsoft document, page 94 (emphasis added).

Thus, even if combined, the references do not teach replying automatically to service requests as recited in claims 22 and 29. According to the Microsoft document itself, second, third, and any further messages from any particular sender simply will not be answered.

Furthermore, the Examiner has provided no reasonable basis for combining these references. The Examiner, on the contrary, appears to have suggested an improvement to the Jago system based entirely upon either the present application or pure speculation on the part of the Examiner. The Examiner's actual reasoning is summarized as follows:

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's [sic] invention was made to incorporate the auto-reply feature and/or the idea of the same to enhance Jago's e-mail capability, with the motivation, to enable responding without human intervention with Jago's system. Because the elimination of human intervention would obviously saving cost [sic] while assuring clients' [sic] that the request has reached the designated destination, such as service center, or the like.

Jago clearly provides no teaching whatsoever for automatic reply to a service request. One skilled in the art could only conclude either that the Jago system was incapable of providing such automatic response, or that for some reason Jago preferred not to provide such responses. If it is assumed that Jago intended to make a useable, cost-effective and commercially successful product, the very motivation submitted by the Examiner would have motivated Jago to include such automatic replies. Because Jago did not, one skilled in the art can only conclude from the reference that the absence of such "well known technology" could only have been a matter of conscious choice. That is, the motivation suggested by the Examiner is not reasonable, and Jago himself did not find it to be so.

The absence of an automatic acknowledgment feature in a service request handling approach, such as that recited in claims 22 and 29, would not necessarily have motivated a person skilled in the art to modify the Jago system to include such automatic response capabilities. Indeed, the Jago system might operate quite effectively without automatic responses to service requests. The service requests could be responded to quickly and effectively by human intervention, *or* perhaps Jago simply preferred to have a human operator reply to service requests. Certainly, nothing in the references in any way suggests the modification proposed by the Examiner.

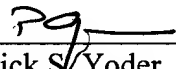
In conclusion, because the references, even if combined, do not enable the invention recited in claims 22 and 29, and because there is no reasonable motivation for combining the references as proposed, claims 22 and 29, and claims depending therefrom, are believed to be clearly allowable over the cited prior art. Reconsideration and allowance of all pending claims are therefore requested.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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